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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/513,646	
	Filing Date	02/25/2000	
	First Named Inventor	Daniel A. Ford	
	Art Unit	2645	
	Examiner Name	Ovidio Escalante	
Total Number of Pages in This Submission	124	Attorney Docket Number	AM9-99-0165

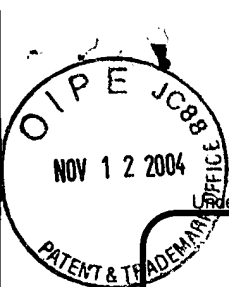
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☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 340.00

Complete if Known

Application Number	09/513,646
Filing Date	02/25/2000
First Named Inventor	Daniel A. Ford
Examiner Name	Escalante, Ovidio
Art Unit	2645
Attorney Docket No.	AM9-99-0165

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

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Deposit Account Name: IBM Corporation

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments

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FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$) 0.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims: -20** = X =
Independent Claims: -3** = X =
Multiple Dependent: =

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$) 0.00

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FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	340.00
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

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SUBTOTAL (3) (\$) 340.00

SUBMITTED BY

Name (Print/Type)	Leonard T. Guzman	Registration No. (Attorney/Agent)	46,308	Telephone	408-927-3377
Signature		Date	10/6/2004		

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PATENT

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Title: "SYSTEM AND TECHNIQUE FOR DYNAMICALLY INTERJECTING
LIVE ADVERTISEMENTS IN THE CONTEXT OF REAL-TIME
ISOCHRONOUS (TELEPHONE-MODEL) DISCOURSE"

Applicants: Ford et al.

Attorney Docket No.: AM9-99-0165

Serial No.: 09/513,646

Examiner: Ovidio Escalante

Filed: February 25, 2000

Art Unit: 2645

5

Mail Stop: Board of Patent Appeals and Interferences
Commissioner for Patents
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APPEAL BRIEF

Dear Sir:

This appeal brief is submitted under 35 U.S.C. §134. This appeal is further to Appellants'

10 Notice of Appeal filed August 6, 2004.

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(1) Real Party in Interest

The real party in interest is International Business Machines Corporation.

(2) Related Appeals and Interferences

No other appeals or interferences exist that relate to the present application or appeal.

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(3) Status of Claims

Claims 1-13 are pending and remain in the application. By the Final Office Action dated May 6, 2004, the Examiner has rejected claims 1-13 under 35 U.S.C. § 103(a). In particular, the Examiner has rejected claims 1, 2, 5, 6, 10, and 11 as being unpatentable over Ordish, U.S. Patent No. 5,195,031 (hereinafter Ordish) in view of Sawyer, U.S. Patent No. 6,351,279 (hereinafter Sawyer). In addition, the Examiner has rejected claims 3, 4, 7-9, 12, and 13 as being unpatentable over Sawyer in view of Ordish. All of the pending claims and all of the rejections are hereby appealed. A copy of the appealed claims is enclosed herewith as Appendix A.

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(4) Status of Amendments

No amendments are outstanding.

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(5) Summary of Claimed Subject Matter

Independent Claim 1

Independent claim 1 relates to a method of interjecting messages into a real-time isochronous discourse between a plurality of users, where the method includes the steps of (1) providing a system for accessing a real-time isochronous discourse on a telephone between two or more callers, (2) accessing a real-time isochronous discourse on the telephone between two or more callers, (3) monitoring the discourse on the telephone between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system, (4) communicating the desired message via the telephone to the callers when the discourse is determined to be related to the desired message, and (5) continuing the above

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steps until the discourse being accessed is terminated by the callers or the system. (Please see Application as Filed, page 17, lines 1-9.)

Independent Claim 3

5 Independent claim 3 relates to a method of of interjecting messages into a real-time isochronous discourse between a plurality of callers is provided, where the method includes the steps of (1) forming a system including (a) a system interface for inputting and storing system parameters by an owner of the system, (b) a communication media interface for communicating with a telephone system being used by two or more callers, (c) a conversation content analyzer and summarizer for determining if the communication on the telephone
10 system between the callers is relevant to the system parameters, (d) a database for storing system data including system messages to be transmitted to the callers, (e) a database manager for matching system parameters with the communication on the telephone system between the callers, and (f) a caller interface for communicating the system data and/or messages to one or more of the callers, (2) accessing the telephone system being used by two
15 or more callers using the communication media interface, (3) monitoring the communication on the telephone system between the callers using the communication media interface, (4) analyzing the conversation on the telephone system using the conversation content analyzer and summarizer, (5) determining if there is a match between the conversation on the telephone system and one or more of the system parameters using the database manager, (6)
20 sending the system data from the database to the database manager if there is a match and choosing a suitable message from the database for communication to the caller, and (7) transmitting the message via the telephone system to the callers using the caller interface. (Please see Application as Filed, page 17, lines 1-13 to page 18, lines 14-26.)

Independent Claim 5

25 Independent claim 5 relates to a system for interjecting messages into a real-time isochronous discourse between a plurality of users, where the system includes (1) means for accessing a real-time isochronous discourse on a telephone between two or more callers, (2) means for monitoring the discourse on the telephone between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system, and

(3) means for communicating the desired message via the telephone to the callers when the discourse is determined to be related to the desired message. (Please see Application as Filed, page 18, lines 1-7.)

5 The means plus function “means for accessing a real-time isochronous discourse on a telephone between two or more callers” of claim 5 corresponds to the following structure, material, or acts described in the specification as corresponding to the claimed function: “Specifically, based upon the system owner’s inputting and storing system parameters, the system will access a telephone conversation between one or more callers and look for a match between system parameters and the conversation, e.g., the temporally contiguous occurrence
10 of a particular keyword or set of keywords.” (Please see Application as Filed, page 8, lines 16-19.)

The means plus function “means for monitoring the discourse on the telephone between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system” of claim 5 corresponds to the following structure,
15 material, or acts described in the specification as corresponding to the claimed function: “The use of the above parameters by the system will be further described hereinbelow but it should be understood that any number of parameters can be used depending on how the system is to be used with the system essentially providing access to a real-time isochronous discourse between two or more callers which discourse is monitored and when the discourse
20 is determined to relate to a message desired to be communicated to the callers by the system, the desired message is communicated”. (Please see Application as Filed, page 10, lines 7-13.).

The means plus function “means for communicating the desired message via the telephone to the callers when the discourse is determined to be related to the desired message”
25 of claim 5 corresponds to the following structure, material, or acts described in the specification as corresponding to the claimed function: “The use of the above parameters by the system will be further described hereinbelow but it should be understood that any number of parameters can be used depending on how the system is to be used with the system essentially providing access to a real-time isochronous

discourse between two or more callers which discourse is monitored and when the discourse is determined to relate to a message desired to be communicated to the callers by the system, the desired message is communicated". (Please see Application as Filed, page 10, lines 7-13.).

5 **Independent Claim 7**

 Independent claim 7 relates to a system for interjecting messages into a real-time isochronous discourse between a plurality of callers, where the system includes (1) means for forming a system including (a) a system interface for inputting and storing system parameters by the owner of the system, (b) a communication media interface for communicating with a
10 telephone system being used by two or more callers, (c) a conversation content analyzer and summarizer for determining if the communication on the telephone system between the callers is relevant to the system parameters, (d) a database for storing system data including system messages to be transmitted to the callers, (e) a database manager for matching system parameters with the communication on the telephone system between the callers, and (f) a
15 caller interface for communicating the system data and/or messages to one or more of the callers and (2) where the telephone system being used by two or more callers is accessed using the communication media interface, (a) the communication on the telephone system between the callers is monitored using the communication media interface, (b) the conversation on the telephone system is analyzed using the conversation content analyzer and
20 summarizer, and (c) the conversation on the telephone system is compared with one or more of the system parameters using the database manager and, if there is a match, sending the system data from the database to the database manager and choosing a suitable message from the database for communication to the callers and transmitting the message via the telephone system to the callers using the caller interface. (Please see Application as Filed, page 18, lines
25 1-2 to page 19, lines 3-24.)

 The means plus function "means for forming a system" of claim 7 corresponds to the following structure, material, or acts described in the specification as corresponding to the claimed function: "The owner or operator of the system would merely need to specify system parameters such as sets of keywords, typically sequence dependent, to be detected in the

context of the conversation and intended to be matched to trigger interjecting advertisements into the telephone conversation.” (Please see Application as Filed, page 9, lines 22-25.)

Independent Claim 10

Independent claim 10 relates to a program storage device readable by a machine,
5 tangibly embodying a program of instructions executable by the machine to perform method
steps for interjecting messages into a real-time isochronous discourse between a plurality of
users including the steps of (1) providing a system for accessing a real-time isochronous
discourse on a telephone between two or more callers, (2) accessing a real-time isochronous
discourse on the telephone between two or more callers, (3) monitoring the discourse on the
10 telephone between the callers to determine if the discourse relates to a message desired to be
communicated to the callers by the system, (4) communicating the desired message via the
telephone to the callers when the discourse is determined to be related to the desired message,
and (5) continuing the above steps until the discourse being accessed is terminated by the
callers or the system. (Please see Application as Filed, page 20, lines 1-13.)

15 **Independent Claim 12**

Independent claim 12 relates to a A program storage device readable by a machine,
tangibly embodying a program of instructions executable by the machine to perform a method
of interjecting messages into a real-time isochronous discourse between a plurality of callers
including the steps of (1) forming a system including (a) a system interface for inputting and
20 storing system parameters by an owner of the system, (b) a communication media interface
for communicating with a telephone system being used by two or more callers, (c) a
conversation content analyzer and summarizer for determining if the communication on the
telephone system between the callers is relevant to the system parameters, (d) a database for
storing system data including system messages to be transmitted to the callers, (e) a database
25 manager for matching system parameters with the communication on the telephone system
between the callers, and (f) a caller interface for communicating the system data and/or
messages to one or more of the callers, (2) accessing the telephone system being used by two
or more callers using the communication media interface, (3) monitoring the communication
on the telephone system between the callers using the communication media interface, (4)

analyzing the conversation on the telephone system using the conversation content analyzer and summarizer, (5) determining if there is a match between the conversation on the telephone system and one or more of the system parameters using the database manager, (6) sending the system data from the database to the database manager if there is a match and
5 choosing a suitable message from the database for communication to the callers, and (7) transmitting the message via the telephone system to the callers using the caller interface. (Please see Application as Filed, page 20, lines 1-11 to page 21, lines 12-28.)

(6) Grounds of Rejection to be Reviewed on Appeal

The first issue for review is whether claims 1, 2, 5, 6, 10, and 11 are unpatentable over
10 Ordish in view of Sawyer. The second issue for review is whether claims 3, 4, 7-9, 12, and 13 are unpatentable over Sawyer in view of Ordish.

(7) Argument

A. Introduction

The first issue for review is whether claims 1, 2, 5, 6, 10, and 11 are unpatentable over
15 Ordish in view of Sawyer. The second issue for review is whether claims 3, 4, 7-9, 12, and 13 are unpatentable over Sawyer in view of Ordish.

B. Whether claims 1, 2, 5, 6, 10, and 11 are unpatentable over Ordish in view of Sawyer

Applicants respectfully traverse the obviousness rejection of claims 1, 2, 5, 6, 10, and 11 over Ordish in view of Sawyer, and submit that claims 1, 2, 5, 6, 10, and 11 are not obvious
20 over Ordish in view of Sawyer, and are patentable thereover. In support of this position, Applicants submit the following argument.

1. Legal Standards for Obviousness

The following legal authorities set the general standards in support of Applicant's position of non obviousness, with emphasis added for added clarity:

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- MPEP §2143.03, "All Claim Limitations Must Be Taught or Suggested: To establish prima facie obviousness of a claimed invention, **all the claim limitations must be taught or suggested by the prior art**. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

5 **"All words in a claim must be considered** in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

- 10 • MPEP §2143.01, "The Prior Art Must Suggest The Desirability Of The Claimed Invention: There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (**The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.**). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).
- 20 • **"Obviousness cannot be established** by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion** supporting the combination." In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). **What a reference teaches** and whether it teaches toward or **away from the claimed invention** are questions of fact. See Raytheon Co. v. Roper Corp., 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984). "
- 25 • "When a rejection depends on a combination of prior art references, there must be **some teaching, suggestion, or motivation** to combine the references. See In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)." **Obviousness can only be established by combining or modifying** the teachings of the prior art to produce the claimed invention **where there is some teaching, suggestion, or motivation** to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).
- 30 • "With respect to core factual findings in a determination of patentability, however, the **Board cannot simply reach conclusions based on its own understanding or experience** -- or on its assessment of what would be basic knowledge or common sense. **Rather, the Board must point to some concrete evidence in the record** in support of these findings." See In re Zurko, 258 F.3d 1379 (Fed. Cir. 2001).
- 35 • "We have noted that **evidence of a suggestion, teaching, or motivation to combine** may flow from the prior art references themselves, the knowledge of one of ordinary skill in

the art, or, in some cases, from the nature of the problem to be solved, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), *Para-Ordinance Mfg. v. SGS Imports Intern., Inc.*, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," *Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, **the showing must be clear and particular**. See, e.g., *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. **Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."** E.g., *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). See *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999).

- "To prevent the use of hindsight based on the invention to defeat patentability of the invention, **this court requires the examiner to show a motivation to combine the references** that create the case of obviousness. In other words, **the examiner must show reasons** that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references **for combination in the manner claimed**." See *In re Rouffet*, 149, F.3d 1350 (Fed. Cir. 1998).
- The mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests the desirability of the combination**. In *re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, **there must be a suggestion or motivation in the reference** to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).
- If the **proposed modification would render the prior art invention being modified unsatisfactory** for its intended purpose, **then there is no suggestion or motivation** to make the proposed modification. In *re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

2. Application of the Obviousness Standard to the Present Invention

By the Final Office Action dated May 6, 2004, the Examiner has rejected claims 1, 2, 5, 6, 10, and 11 as being unpatentable over Ordish in view of Sawyer. In order to form a proper obviousness rejection of a claim under 35 U.S.C. § 103(a), a collection of references together must teach or suggest each element of the claim, including the relationships between

the elements. If any element is not fully taught by the combined references, the rejection cannot be sustained.

Evaluating Ordish in view of Sawyer in this light, it is appropriate to examine the portions of Ordish in view of Sawyer that the Examiner has pointed to as teaching the claimed elements of the rejected claims.

The Examiner has asserted that

[r]egarding claims 1, 2, 5, 6, 10, and 11, Ordish teaches a method, program storage device readable by a machine to perform the method steps and a system comprising means for interjecting messages into a real-time isochronous discourse between a plurality of users (abstract; col. 2, line 57-col. 3, line 32) comprising: providing a system (col. 3, lines 12-18; col. 5, lines 26-44) for accessing a real-time isochronous discourse on a video communication between two or more callers, (col. 5, lines 26-64); accessing a real-time isochronous discourse on a video communication between two or more callers, (col. 3, lines 12-18; col. 5, lines 44-64); monitoring the discourse on the video communication between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system, (col. 3, lines 18-32; col. 5, lines 44-64; col. 10, lines 63-col. 11, lines 17; abstract); and communicating the desired message via the video communication to the callers when the discourse is determined to be related to the desired message, (col. 3, lines 1-32); and continuing the above steps until the discourse being accessed is terminated by the callers or the system, (col. 3, lines 1-32).

(See Final Office Action, page 2, paragraph 5 to page 3.) Then, the Examiner asserted that "Ordish teaches that it was well known to use landline connections in a telephone network for video communication and that two way conversations via the telephone was well known in

the art . . . [and] [that] Ordish further suggests in col. 5, lines 51-55 that any type of video communication can be used.” (See Final Office Action, page 3, paragraph 1.)

The Examiner then admitted that “Ordish, however, does not specifically teach of the discourse occurring via a telephone.” (See Final Office Action, page 3, paragraph 1.) The

5 Examiner then asserted that “Sawyer teaches that is was well known in the art to communicate a desired message via a video telephone (‘on a telephone’) to callers, (abstract; col. 1, lines 63-65; col. 2, line 63-col.3, line 8).” (See Final Office Action, page 3, paragraph 2.) Finally, the Examiner asserted that

10 it would have been obvious to one of ordinary skill
in the art at the time the invention was made to modify the system of
Ordish by including a telephone for making the call as taught and
suggested by Sawyer so that any type of video communication can be
used as suggested by Ordish and so that video telephone can be used to
15 provide voice communication to the end users as taught by Sawyer.

(See Final Office Action, page 3, paragraph 3.)

Claim 1

20 To the extent the Examiner's language at pages 2 and 3 of the Final Office Action can be understood, it appears that the Examiner has asserted the following correspondence between Ordish and Sawyer and claim 1:

<u>Claim 1</u>	<u>Ordish</u>	<u>Sawyer</u>
A method of interjecting messages into a real-time isochronous discourse between a plurality of users comprising the steps of:	-	-
providing a system	<u>Ordish</u> does not teach this	-

for accessing a real-time isochronous discourse <i>on a telephone</i> between two or more callers;	claim element.	
accessing a real-time isochronous discourse <i>on the telephone</i> between two or more callers;	<u>Ordish</u> does not teach this claim element.	-
monitoring the discourse <i>on the telephone</i> between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system;	<u>Ordish</u> does not teach this claim element.	<u>Sawyer</u> does not teach this claim element.
communicating the desired message <i>via the telephone</i> to the callers when the discourse is determined to be related to the desired message; and	<u>Ordish</u> does not teach this claim element.	<u>Sawyer</u> does not teach this claim element.
continuing the above steps until the discourse being accessed is terminated by the callers or	-	-

the system.		
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In reviewing the cited portions of Ordish and Sawyer, however, it becomes apparent that Ordish and Sawyer have been generalized, and, in fact, does not support the position asserted by the Examiner.

5 **monitoring the discourse on the telephone between the callers to**
determine if the discourse relates to a message desired to be
communicated to the callers by the system

In particular, Ordish and Sawyer, alone or in combination, fail to teach or suggest
“monitoring the discourse *on the telephone* between the callers to determine if the discourse
10 relates to a message desired to be communicated to the callers by the system”, as required by
claim 1, as amended. Since the Examiner admitted that “Ordish, however, does not
specifically teach of the discourse occurring via a telephone.” (See Final Office Action, page
3, paragraph 1.), Ordish cannot teach the claim 1 element of “monitoring the discourse *on the*
telephone between the callers to determine if the discourse relates to a message desired to be
15 communicated to the callers by the system” since Ordish does not teach that the discourse that
it is monitoring is “occurring via a telephone”, and, thus, Ordish cannot teach or suggest the
claim 1 element of “monitoring the discourse *on the telephone* between the callers to
determine if the discourse relates to a message desired to be communicated to the callers by
the system”. Moreover, Ordish teaches away from the claim 1 element of “monitoring the
20 discourse *on the telephone* between the callers to determine if the discourse relates to a
message desired to be communicated to the callers by the system” because Ordish discloses
obtaining “characters from the text buffer using the routine readch as described above [and] . .
. [i]f the characters constitute a recognized word in the vocabulary, a reference to this word is
preferably recorded.” (See Ordish, col. 11, lines 7-11.) Thus, Ordish discloses monitoring
25 text in a text buffer and monitoring a *textual* discourse on a *video communication device* that
can display the textual discourse and not discourse on a *telephone* between callers, as required
by claim 1. Also, Ordish teaches away from this claim 1 element because Ordish specifically
discloses a video communication trading system that attempts to solve the problems of using a

telephone system to analyze and transmit trading messages by affirmatively saying that a “telephone system does not provide any hard copy nor does it allow you to, on the same device, obtain supplementary data while carrying on the conversation . . . [where] [s]uch supplementary data may be particularly important if the purpose of the conversation is commodity dealing, such as in the money or foreign exchange market.” (See Ordish, col. 1, lines 37-43.) In other words, Ordish specifically disavows using a telephone system to monitor discourse between callers for at least this reason. Therefore, Ordish cannot teach or suggest the claim 1 element of “monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system”.

In addition, since the Examiner admitted that Sawyer does not teach “monitoring the discourse between the callers” (See First Office Action, page 6, paragraph 1.), Sawyer cannot teach or suggest the claim 1 element of “monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system”. Therefore, Ordish and Sawyer, alone or in combination, alone or in combination, cannot teach or suggest the claim 1 element of “monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system”.

communicating the desired message via the telephone to the callers when the discourse is determined to be related to the desired message

Also, Ordish and Sawyer, alone or in combination, alone or in combination, fail to teach or suggest “communicating the desired message *via the telephone* to the callers when the discourse is determined to be related to the desired message”, as required by claim 1, as amended. Ordish teaches away from this claim 1 element because Ordish specifically discloses a video communication trading system that attempts to solve the problems of using a telephone system to analyze and transmit trading messages by affirmatively saying that a “telephone system does not provide any hard copy nor does it allow you to, on the same device, obtain supplementary data while carrying on the conversation . . . [where] [s]uch

supplementary data may be particularly important if the purpose of the conversation is commodity dealing, such as in the money or foreign exchange market.” (See Ordish, col. 1, lines 37-43.) In other words, Ordish specifically disavows using a telephone system to communicate messages between callers for at least this reason. Therefore, Ordish cannot teach or suggest the claim 1 element of “communicating the desired message *via the telephone* to the callers when the discourse is determined to be related to the desired message”. Since the Examiner admitted that Sawyer does not teach “communication a message related to the discourse” (See First Office Action, page 6, paragraph 1.), Sawyer cannot teach or suggest the claim 1 element of “communicating the desired message *via the telephone* to the callers when the discourse is determined to be related to the desired message”. Therefore, Ordish and Sawyer, alone or in combination, cannot teach or suggest the claim 1 element of “communicating the desired message *via the telephone* to the callers when the discourse is determined to be related to the desired message”.

It is therefore clear that Ordish and Sawyer, alone or in combination, cannot teach or suggest each element of claim 1 and, therefore, a rejection of claim 1 under 35 U.S.C. § 103(a) is inappropriate.

Claim 2

Since dependent claim 2 depends on claim 1 and since Ordish and Sawyer, alone or in combination, cannot teach or suggest each element of claim 1, Ordish and Sawyer, alone or in combination, cannot teach or suggest each element of claim 2, and, therefore, a rejection of claim 2 under 35 U.S.C. § 103(a) is inappropriate.

Claim 5

To the extent the Examiner's language at pages 2 and 3 of the Final Office Action can be understood, it appears that the Examiner has asserted the following correspondence between Ordish and Sawyer and claim 5, as amended:

<u>Claim 5</u>	<u>Ordish</u>	<u>Sawyer</u>
A system for interjecting messages into a real-time isochronous discourse	-	-

between a plurality of users comprising:		
means for accessing a real-time isochronous discourse <i>on a telephone</i> between two or more callers;	<u>Ordish</u> does not teach this claim element.	-
means for monitoring the discourse <i>on the telephone</i> between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system; and	<u>Ordish</u> does not teach this claim element.	<u>Sawyer</u> does not teach this claim element.
means for communicating the desired message <i>via the telephone</i> to the callers when the discourse is determined to be related to the desired message.	<u>Ordish</u> does not teach this claim element.	<u>Sawyer</u> does not teach this claim element.

In reviewing the cited portions of Ordish and Sawyer, however, it becomes apparent that Ordish and Sawyer have been generalized, and, in fact, does not support the position asserted by the Examiner.

means for monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system

In particular, Ordish and Sawyer, alone or in combination, fail to teach or suggest
5 “means for monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system”, as required by claim 5, as amended, for similar reasons that Ordish and Sawyer, alone or in combination, cannot teach or suggest the claim 1 element of “monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be
10 communicated to the callers by the system”.

means for communicating the desired message *via the telephone* to the callers when the discourse is determined to be related to the desired message

Also, Ordish and Sawyer, alone or in combination, fail to teach or suggest “means for
15 communicating the desired message *via the telephone* to the callers when the discourse is determined to be related to the desired message”, as required by claim 5, as amended, for similar reasons that Ordish and Sawyer, alone or in combination, cannot teach or suggest the claim 1 element of “communicating the desired message *via the telephone* to the callers when the discourse is determined to be related to the desired message”.

20 It is therefore clear that Ordish and Sawyer, alone or in combination, cannot teach or suggest each element of claim 5 and, therefore, a rejection of claim 5 under 35 U.S.C. § 103(a) is inappropriate.

Claim 6

Since dependent claim 6 depends on claim 5 and since Ordish and Sawyer, alone or in
25 combination, cannot teach or suggest each element of claim 5, Ordish and Sawyer, alone or in combination, cannot teach or suggest each element of claim 6, and, therefore, a rejection of claim 6 under 35 U.S.C. § 103(a) is inappropriate.

Claim 10

Since claim 10, as amended, is the program storage device version of claim 1, as amended, with the same elements as claim 1, as amended, and since Ordish and Sawyer, alone or in combination, cannot teach or suggest each element of claim 1, as amended, Ordish and Sawyer, alone or in combination, cannot teach or suggest each element of claim 10, as amended, and therefore, a rejection of claim 10, as amended, under 35 U.S.C. § 103(a) is inappropriate.

Claim 11

Since dependent claim 11 depends on claim 10 and since Ordish and Sawyer, alone or in combination, cannot teach or suggest each element of claim 10, Ordish and Sawyer, alone or in combination, cannot teach or suggest each element of claim 11, and, therefore, a rejection of claim 11 under 35 U.S.C. § 103(a) is inappropriate.

C. Whether claims 3, 4, 7-9, 12, and 13 are unpatentable over Sawyer in view of Ordish

Applicants respectfully traverse the obviousness rejection of claims 3, 4, 7-9, 12, and 13 over Sawyer in view of Ordish, and submit that claims 3, 4, 7-9, 12, and 13 are not obvious over Sawyer in view of Ordish, and are patentable thereover. In support of this position, Applicants submit the following argument.

1. Legal Standards for Obviousness

The following legal authorities set the general standards in support of Applicant's position of non obviousness, with emphasis added for added clarity:

- MPEP §2143.03, "All Claim Limitations Must Be Taught or Suggested: To establish prima facie obviousness of a claimed invention, **all the claim limitations must be taught or suggested by the prior art**. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). **"All words in a claim must be considered** in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."
- MPEP §2143.01, "The Prior Art Must Suggest The Desirability Of The Claimed Invention: There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (**The combination of the references taught every element of**

the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

- 5 • “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” In *re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). What a reference teaches and whether it teaches toward or away from the claimed invention are questions of fact. See *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984). “
- 15 • “When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).” Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so
- 20 found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).
- 25 • “With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of
- 30 these findings.” See *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001).
- 35 • “We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), *Para-Ordinance Mfg. v. SGS Imports Intern., Inc.*, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although “the suggestion more often comes from the teachings of the pertinent references,” *Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual
- 40 evidence. That is, the showing must be clear and particular. See, e.g., *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.” E.g., *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) (“Mere denials and conclusory statements, however, are not sufficient to establish a

genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)." See In re Dembiczak, 175 F. 3d 994 (Fed. Cir. 1999).

- 5 • "To prevent the use of hindsight based on the invention to defeat patentability of the invention, **this court requires the examiner to show a motivation to combine the references** that create the case of obviousness. In other words, **the examiner must show reasons** that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references **for combination in the manner claimed.**" See In re Rouffet, 149, 10 F.3d 1350 (Fed. Cir. 1998).
- 15 • The mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests the desirability of the combination.** In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, **there must be a suggestion or motivation in the reference** to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).
- 20 • If the **proposed modification would render the prior art invention being modified unsatisfactory** for its intended purpose, **then there is no suggestion or motivation** to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

25 2. **Application of the Obviousness Standard to the Present Invention**

By the Final Office Action dated April 15, 2003, the Examiner has rejected claims 3, 4, 7-9, 12, and 13 as being unpatentable over Sawyer in view of Ordish. In order to form a proper obviousness rejection of a claim under 35 U.S.C. § 103(a), a collection of references together must teach or suggest each element of the claim, including the relationships between 30 the elements. If any element is not fully taught by the combined references, the rejection cannot be sustained.

Evaluating Sawyer in view of Ordish in this light, it is appropriate to examine the portions of Sawyer in view of Ordish that the Examiner has pointed to as teaching the claimed elements of the rejected claims.

35 The Examiner has asserted that

[r]egarding claims 3, 7 and 12, Sawyer teaches a method, system and

program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform the method and a system comprising means for interjecting messages into a real-time isochronous discourse between a plurality of callers is provided (abstract; col. 1, lines 63-65; col. 3, line 63-65; col. 3, lines 29-52) comprising: forming a system comprising: a system interface for inputting and storing system parameters by an owner of the system, (col. 4, lines 8-32); a communication media interface for communicating with a telephone system (video telephone system) being used by two or more callers, (col. 2, line 63-col. 3, line 8; fig. 3); a database for storing system data including system messages to be transmitted to the callers, (col. 3, lines 9-28); a caller interface for communicating the system data and/or messages to one or more of the callers, (col. 3, lines 9-8, col. 4, lines 33-50).

(See Final Office Action, page 4, paragraph 1.) Then, the Examiner admitted that "Sawyer does not specifically teach of a conversation analyzer and choosing a message based on the conversation." (See Final Office Action, page 4, paragraph 1.)

The Examiner then asserted that

Ordish teaches that it was well known in the art to have a conversation content analyzer and summarizer for determining if the communication on the video communication system between the callers is relevant to the system parameters, (col. 2, line 57- col. 3, line 32); a database manager for matching system parameters with the communication on the video communication system between the callers, (col. 3, lines 12-18; col. 5, lines 26-64); and accessing the video communication system being used by two or more callers using the communication media interface, (col. 3, lines 12-18; col.5, lines 44-64);

monitoring the communication on the video communication system between the callers using the communication media interface, (col. 10, line 63-col. 11, line 17; col. 5, lines 44-64; abstract); analyzing the conversation on the video communication system using the conversation content analyzer and summarizer, (col. 3, lines 1-32; col. 5, lines 44-64); determining if there is a match between the conversation on the video communication system and one or more of the system parameters using the database manager, (col. 5, lines 44-64); sending the system data from the database to the database manager if there is a match and choosing a suitable message from the database for communication to the callers, (col. 3, lines 1-32; col. 10, line 63-col. 11, line 17; and transmitting the message via the video communication system to the callers using the caller interface, (col. 3, lines 1-32).

15 (See Final Office Action, page 4, paragraph 3 to page 5.) Then, the Examiner asserted that

since Ordish teaches that it was well known to use landline connections in a telephone network for video communication and since Sawyer teaches that the video communication is a video telephone communication then one skilled in the art would have used the well known teaching of monitoring video communications as shown by Ordish into the video communication (video telephony system) of Sawyer so that real-time messages can be sent to the end parties.

25 (See Final Office Action, page 5, paragraph 1 to page 6.)

Finally, the Examiner asserted that

[t]herefore, it would have been obvious to one of ordinary skill

in the art at the time the invention was made to modify the system of Sawyer by using a conversation analyzer to provide the callers with customized announcements based on their conversation as taught by Ordish so that the system can provide adaptive advertisements that is based upon the users interest and transactions based on their real-time conversation.

(See Final Office Action, page 6, paragraph 1.)

Claim 3

To the extent the Examiner's language at pages 3-6 of the Final Office Action can be understood, it appears that the Examiner has asserted the following correspondence between Sawyer and Ordish and claim 3, as amended:

<u>Claim 3</u>	<u>Sawyer</u>	<u>Ordish</u>
A method of interjecting messages into a real-time isochronous discourse between a plurality of callers is provided comprising the steps of:	-	-
forming a system comprising:	<u>Sawyer</u> does not teach this claim element.	<u>Ordish</u> does not teach this claim element.
a system interface for inputting and storing system parameters by an owner of the system;	-	-
a	-	<u>Ordish</u> does not teach this

<p>communication media interface for communicating with <i>a telephone</i> system being used by two or more callers;</p> <p>a conversation content analyzer and summarizer for determining if the communication <i>on the telephone system</i> between the callers is relevant to the system parameters;</p> <p>a database for storing system data including system messages to be transmitted to the callers;</p> <p>a database manager for matching system parameters with the communication <i>on the telephone system</i> between the callers; and</p> <p>a caller interface for communicating the system data and/or messages to</p>	<p><u>Sawyer</u> does not teach this claim element.</p> <p>-</p> <p><u>Sawyer</u> does not teach this claim element.</p> <p>-</p>	<p>claim feature.</p> <p><u>Ordish</u> does not teach this claim feature.</p> <p>-</p> <p><u>Ordish</u> does not teach this claim feature.</p> <p>-</p>
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one or more of the callers;		
accessing the <i>telephone</i> system being used by two or more callers using the communication media interface;	-	<u>Ordish</u> does not teach this claim element.
monitoring the communication <i>on the telephone system</i> between the callers using the communication media interface;	<u>Sawyer</u> does not teach this claim element.	<u>Ordish</u> does not teach this claim element.
analyzing the conversation <i>on the telephone system</i> using the conversation content analyzer and summarizer;	<u>Sawyer</u> does not teach this claim element.	<u>Ordish</u> does not teach this claim element.
determining if there is a match between the conversation <i>on the telephone system</i> and one or more of the system parameters using the database manager;	<u>Sawyer</u> does not teach this claim element.	<u>Ordish</u> does not teach this claim element.

<p>sending the system data from the database to the database manager if there is a match and choosing a suitable message from the database for communication to the callers; and</p>	<p><u>Sawyer</u> does not teach this claim element.</p>	-
<p>transmitting the message <i>via the telephone system</i> to the callers using the caller interface.</p>	-	<p><u>Ordish</u> does not teach this claim element.</p>

In reviewing the cited portions of Sawyer and Ordish, however, it becomes apparent that Sawyer and Ordish have been generalized, and, in fact, does not support the position asserted by the Examiner.

5 **forming a system**

In particular, Sawyer and Ordish, alone or in combination, fail to teach or suggest the “forming a system” element, as required by claim 3, as amended, since Sawyer and Ordish, alone or in combination, fail to teach or suggest all of the claim features of the “forming a system” element.

10 **a conversation content analyzer and summarizer for**
determining if the communication on the telephone system
between the callers is relevant to the system parameters

15 In particular, Sawyer and Ordish, alone or in combination, fail to teach or suggest “a conversation content analyzer and summarizer for determining if the communication *on the telephone system* between the callers is relevant to the system parameters”, as required by claim 3, as amended. Since Ordish cannot teach the claim 1 feature of claim 1 element of

“monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system”, Ordish cannot teach this claim 3 feature of analyzing that which Ordish cannot monitor. Therefore, Ordish cannot teach or suggest the claim 3 feature of “a conversation content analyzer and
5 summarizer for determining if the communication *on the telephone system* between the callers is relevant to the system parameters”. Since the Examiner admitted that Sawyer does not teach “a conversation content analyzer”, Sawyer cannot teach or suggest the claim 3 feature of “a conversation content analyzer and summarizer for determining if the communication *on the telephone system* between the callers is relevant to the system parameters”. Therefore,
10 Sawyer and Ordish, alone or in combination, cannot teach or suggest the claim 3 feature of “a conversation content analyzer and summarizer for determining if the communication *on the telephone system* between the callers is relevant to the system parameters”. Since Sawyer and Ordish, alone or in combination, cannot teach or suggest all of the claim features of the “forming a system” element of claim 3, as amended, Sawyer and Ordish, alone or in
15 combination, cannot teach or suggest the claim 3 element of “forming a system”.

**monitoring the discourse on the telephone between the callers to
determine if the discourse relates to a message desired to be
communicated to the callers by the system**

In addition, Sawyer and Ordish, alone or in combination, fail to teach or suggest
20 “monitoring the communication *on the telephone system* between the callers using the communication media interface”, as required by claim 3, as amended for similar reasons that Ordish and Sawyer, alone or in combination, cannot teach or suggest the claim 1 element of “monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system”.

**analyzing the conversation on the telephone system using the
conversation content analyzer and summarizer**

Also, Sawyer and Ordish, alone or in combination, fail to teach or suggest “analyzing the conversation *on the telephone system* using the conversation content analyzer and summarizer”, as required by claim 3, as amended for similar reasons that Sawyer and Ordish,

alone or in combination, cannot teach or suggest the the claim 3 feature of “a conversation content analyzer and summarizer for determining if the communication *on the telephone system* between the callers is relevant to the system parameters”.

5 It is therefore clear that Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 3 and, therefore, a rejection of claim 3 under 35 U.S.C. § 103(a) is inappropriate.

Claim 4

10 Since dependent claim 4 depends on claim 3 and since Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 3, Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 4 and, therefore, a rejection of claim 4 under 35 U.S.C. § 103(a) is inappropriate.

Claim 7

15 To the extent the Examiner's language at pages 6, 7, and 8 of the Office Action can be understood, it appears that the Examiner has asserted the following correspondence between Sawyer and Ordish and claim 3, as amended:

<u>Claim 7</u>	<u>Sawyer</u>	<u>Ordish</u>
A system is provided for interjecting messages into a real-time isochronous discourse between a plurality of callers comprising:	-	-
means for forming a system comprising:	<u>Sawyer</u> does not teach this claim element.	<u>Ordish</u> does not teach this claim element.
a system interface for inputting and storing system parameters	-	-

by the owner of the system;		
a		
communication media	-	<u>Ordish</u> does not teach this
interface for		claim feature.
communicating with <i>a</i>		
<i>telephone</i> system being		
used by two or more		
callers;		
a		
conversation content	<u>Sawyer</u> does not teach this	<u>Ordish</u> does not teach this
analyzer and summarizer	claim element.	claim feature.
for determining if the		
communication <i>on the</i>		
<i>telephone system</i> between		
the callers is relevant to the		
system parameters;		
a database	-	-
for storing system data		
including system messages		
to be transmitted to the		
callers;		
a database		
manager for matching	<u>Sawyer</u> does not teach this	<u>Ordish</u> does not teach this
system parameters with the	claim element.	claim feature.
communication <i>on the</i>		
<i>telephone system</i> between		
the callers; and		
a caller	-	-
interface for		

communicating the system data and/or messages to one or more of the callers;		
wherein the <i>telephone</i> system being used by two or more callers is accessed using the communication media interface;	-	<u>Ordish</u> does not teach this claim feature.
the communication <i>on the telephone system</i> between the callers is monitored using the communication media interface;	<u>Sawyer</u> does not teach this claim element.	<u>Ordish</u> does not teach this claim feature.
the conversation <i>on the telephone system</i> is analyzed using the conversation content analyzer and summarizer;	<u>Sawyer</u> does not teach this claim element.	<u>Ordish</u> does not teach this claim feature.
and		
the conversation <i>on the telephone system</i> is compared with one or more of the system parameters using the database manager	<u>Sawyer</u> does not teach this claim element.	<u>Ordish</u> does not teach this claim feature.

and, if there is a match, sending the system data from the database to the database manager and choosing a suitable message from the database for communication to the callers and transmitting the message <i>via the telephone system</i> to the callers using the caller interface.		
--	--	--

In reviewing the cited portions of Sawyer and Ordish, however, it becomes apparent that Sawyer and Ordish have been generalized, and, in fact, does not support the position asserted by the Examiner.

5 **means for forming a system**

In particular, Sawyer and Ordish, alone or in combination, fail to teach or suggest the “means for forming a system” element, as required by claim 7, as amended. Since the “means for forming a system” element is the “means for” version of the “forming a system” element of claim 3 with the same elements as claim 3 and since Sawyer and Ordish, alone or in
10 combination, cannot to teach or suggest the “forming a system” element of claim 3, Sawyer and Ordish, alone or in combination, also cannot teach or suggest the claim 7 element of “means for forming a system”.

the communication on the telephone system between the callers is monitored using the communication media interface

15 In addition, Sawyer and Ordish, alone or in combination, fail to teach or suggest “the communication *on the telephone system* between the callers is monitored using the communication media interface”, as required by claim 7, as amended. Sawyer and Ordish, alone or in combination, cannot teach or suggest the claim 3 element of “monitoring the

communication *on the telephone system* between the callers using the communication media interface”, Sawyer and Ordish, alone or in combination, cannot teach or suggest the claim 7 feature of “the communication *on the telephone system* between the callers is monitored using the communication media interface”.

5 **the conversation on the telephone system is analyzed using the conversation content analyzer and summarizer**

Also, Sawyer and Ordish, alone or in combination, fail to teach or suggest “the conversation *on the telephone system* is analyzed using the conversation content analyzer and summarizer”, as required by claim 7, as amended. Since Sawyer and Ordish, alone or in
10 combination, cannot teach or suggest the claim 3 element of “analyzing the conversation *on the telephone system* using the conversation content analyzer and summarizer”, Sawyer and Ordish, alone or in combination, cannot teach or suggest the claim 7 feature of “the conversation *on the telephone system* is analyzed using the conversation content analyzer and summarizer”.

15 It is therefore clear that Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 7 and, therefore, a rejection of claim 7 under 35 U.S.C. § 103(a) is inappropriate.

Claim 8

Since dependent claim 8 depends on claim 7 and since Sawyer and Ordish, alone or in
20 combination, cannot teach or suggest each element of claim 7, Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 8 and, therefore, a rejection of claim 8 under 35 U.S.C. § 103(a) is inappropriate.

Claim 9

Since dependent claim 9 depends on claim 8 and since Sawyer and Ordish, alone or in
25 combination, cannot teach or suggest each element of claim 8, Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 9 and, therefore, a rejection of claim 9 under 35 U.S.C. § 103(a) is inappropriate.

Claim 12

Since claim 12, as amended, is the program storage device version of claim 3, as amended, with the same elements as claim 3, as amended, and since Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 3, as amended, Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 12, as amended, and therefore, a rejection of claim 12, as amended, under 35 U.S.C. § 103(a) is inappropriate.

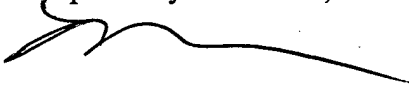
Claim 13

Since dependent claim 13 depends on claim 12 and since Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 12, Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 13 and, therefore, a rejection of claim 13 under 35 U.S.C. § 103(a) is inappropriate.

CONCLUSION

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. It is respectfully submitted that the application has now been brought into a condition where allowance of the case is proper. Reconsideration and issuance of a Notice of Allowance are respectfully solicited.

Respectfully Submitted,


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APPENDIX A

CLAIMS APPENDIX

- 5 1. A method of interjecting messages into a real-time isochronous discourse between a plurality of users comprising the steps of:
- providing a system for accessing a real-time isochronous discourse on a telephone between two or more callers;
- 10 accessing a real-time isochronous discourse on the telephone between two or more callers;
- monitoring the discourse on the telephone between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system;
- communicating the desired message via the telephone to the callers when the discourse is determined to be related to the desired message; and
- 15 continuing the above steps until the discourse being accessed is terminated by the callers or the system.
2. The method of claim 1 wherein the real-time isochronous discourse is a telephone call.
- 20 3. A method of interjecting messages into a real-time isochronous discourse between a plurality of callers is provided comprising the steps of:
- forming a system comprising:
- a system interface for inputting and storing system parameters by an owner of the system;
- 25 a communication media interface for communicating with a telephone system being used by two or more callers;
- a conversation content analyzer and summarizer for determining if the communication on the telephone system between the callers is relevant to the system parameters;

a database for storing system data including system messages to be transmitted to the callers;

a database manager for matching system parameters with the communication on the telephone system between the callers; and

5 a caller interface for communicating the system data and/or messages to one or more of the callers;

accessing the telephone system being used by two or more callers using the communication media interface;

10 monitoring the communication on the telephone system between the callers using the communication media interface;

analyzing the conversation on the telephone system using the conversation content analyzer and summarizer;

determining if there is a match between the conversation on the telephone system and one or more of the system parameters using the database manager;

15 sending the system data from the database to the database manager if there is a match and choosing a suitable message from the database for communication to the callers; and

transmitting the message via the telephone system to the callers using the caller interface.

20 4. The method of claim 3 wherein the isochronous discourse is a telephone call.

5. A system for interjecting messages into a real-time isochronous discourse between a plurality of users comprising:

25 means for accessing a real-time isochronous discourse on a telephone between two or more callers;

means for monitoring the discourse on the telephone between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system; and

means for communicating the desired message via the telephone to the callers when the discourse is determined to be related to the desired message.

6. The system of claim 5 wherein the isochronous discourse is a telephone call.

5

7. A system is provided for interjecting messages into a real-time isochronous discourse between a plurality of callers comprising:

means for forming a system comprising:

10 a system interface for inputting and storing system parameters by the owner of the system;

a communication media interface for communicating with a telephone system being used by two or more callers;

15 a conversation content analyzer and summarizer for determining if the communication on the telephone system between the callers is relevant to the system parameters;

a database for storing system data including system messages to be transmitted to the callers;

a database manager for matching system parameters with the communication on the telephone system between the callers; and

20 a caller interface for communicating the system data and/or messages to one or more of the callers;

wherein the telephone system being used by two or more callers is accessed using the communication media interface;

25 the communication on the telephone system between the callers is monitored using the communication media interface;

the conversation on the telephone system is analyzed using the conversation content analyzer and summarizer; and

the conversation on the telephone system is compared with one or more of the system parameters using the database manager and, if there is a match, sending the system

data from the database to the database manager and choosing a suitable message from the database for communication to the callers and transmitting the message via the telephone system to the callers using the caller interface.

5 8. The system of claim 7 wherein the isochronous discourse is a telephone call.

9. The system of claim 8 wherein different messages are provided to each caller.

10 10. A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform method steps for interjecting messages into a real-time isochronous discourse between a plurality of users comprising the steps of:

providing a system for accessing a real-time isochronous discourse on a telephone between two or more callers;

15 accessing a real-time isochronous discourse on the telephone between two or more callers;

monitoring the discourse on the telephone between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system;

communicating the desired message via the telephone to the callers when the discourse is determined to be related to the desired message; and

20 continuing the above steps until the discourse being accessed is terminated by the callers or the system.

11. The program storage device of claim 10 wherein the real-time isochronous discourse is a telephone call.

25

12. A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform a method of interjecting messages into a real-time isochronous discourse between a plurality of callers comprising the steps of:

forming a system comprising:

a system interface for inputting and storing system parameters by an owner of the system;

a communication media interface for communicating with a telephone system being used by two or more callers;

5 a conversation content analyzer and summarizer for determining if the communication on the telephone system between the callers is relevant to the system parameters;

a database for storing system data including system messages to be transmitted to the callers;

10 a database manager for matching system parameters with the communication on the telephone system between the callers; and

a caller interface for communicating the system data and/or messages to one or more of the callers;

15 accessing the telephone system being used by two or more callers using the communication media interface;

monitoring the communication on the telephone system between the callers using the communication media interface;

analyzing the conversation on the telephone system using the conversation content analyzer and summarizer;

20 determining if there is a match between the conversation on the telephone system and one or more of the system parameters using the database manager;

sending the system data from the database to the database manager if there is a match and choosing a suitable message from the database for communication to the callers; and

25 transmitting the message via the telephone system to the callers using the caller interface.

13. The program storage device of claim 12 wherein the real-time isochronous discourse is a telephone call.

APPENDIX B

EVIDENCE APPENDIX

- 5 There is no applicable evidence.

APPENDIX C

RELATED PROCEEDINGS APPENDIX

- 5 There are no related proceedings.